

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES A. POUTASSE

Appeal No. 96-3584
Application No. 08/267,877¹

ON BRIEF

Before KIMLIN, JOHN D. SMITH and OWENS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-19, all the claims in the present application. A copy of illustrative claim 1 is appended to this decision.

¹ Application for patent filed June 28, 1994.

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The examiner relies upon the following references as
evidence of obviousness:

Armstrong, Jr.	3,935,053	Jan. 27, 1976
Shimizu et al. (Shimizu)	5,061,550	Oct. 29, 1991

Epoxy Resins: Chemistry and Technology pp. 683-91 and 1089-95
(Clayton A. May ed., 2d ed., Marcel Dekker, Inc.) (May)

Appellant's claimed invention is directed to an adhesive composition comprising (A) at least one phenolic resole resin and the reaction product of (B-1) at least one difunctionally epoxy resin, such as a bisphenol A epoxy resin, and (B-2) at least one compound represented by the recited formulae, such as resorcinol.

Appealed claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over May. Claims 8-11, 13, 15, 17 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shimizu in view of May. In addition, claims 8-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shimizu and May in further view of Armstrong.

We have carefully reviewed the respective positions advanced by appellant and the examiner. In so doing, we concur with appellant that the prior art applied by the examiner fails to establish a prima facie case of obviousness

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for the claimed subject matter. Accordingly, we will not sustain the examiner's rejections.

We, like appellant, do not agree with the examiner that May discloses a composition comprising the claimed reaction product of a difunctional epoxy resin and a compound embraced by the recited formulae, e.g., resorcinol. May discloses a reaction product of a phenolic resole resin and a difunctional epoxy resin, and further teaches that such compositions may also contain an accelerator, such as resorcinol. May does not disclose that the resorcinol accelerator reacts with the difunctional epoxy resin, but the examiner maintains that "the composition[s] made obvious by May include 1) a bisphenol A epoxy reacted with resorcinol" (page 9 of Answer). At page 6 of the Final Rejection, the examiner makes the statement that "[i]n order to function as an accelerator to increase the speed of reaction of epoxy resins, accelerators must react with the epoxy as required by the claims." However, appellant notes at page 8 of the Brief that "the Examiner does not offer evidence to support this proposition other than his own statement," and, furthermore, appellant invites attention to an analogous reaction disclosed in May wherein phenol is used

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to accelerate the opening of an epoxy ring (see May at page 298). According to appellant, the mechanism depicted by May "indicates that phenol does not react with the epoxy, but rather hydrogen bonds in the transition state as it is the amine which reacts with the epoxy" (page 8 of Brief).

Accordingly, since May does not disclose that resorcinol, when used as an accelerator in an epoxy resin composition, reacts with the epoxy resin, and appellant has substantively refuted the examiner's statement that such a reaction takes place during acceleration, we look to the examiner for a response to appellant's refutation. However, the Examiner's Answer is silent on this crucial point. Consequently, based on the record before us, we must find that there is insufficient evidence to support the examiner's position.

The other references cited by the examiner, Shimizu and Armstrong, do not remedy the noted deficiency of May.

In conclusion, based on the foregoing, we are constrained to reverse the examiner's rejections.

REVERSED

EDWARD C. KIMLIN

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JOHN D. SMITH)	BOARD OF PATENT
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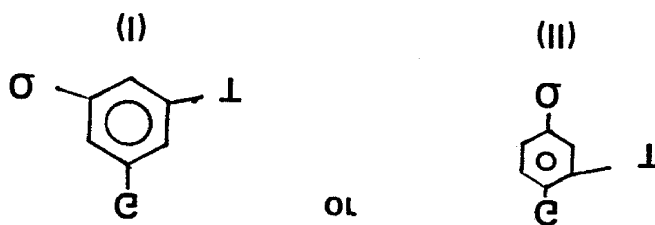
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APPENDIX

1. An adhesive composition, comprising:
- (A) at least one phenolic resole resin; and
- (B) the product made by reacting
- (B-1) at least one difunctional epoxy resin, with
- (B-2) at least one compound represented by the formulae



wherein in Formulae (I) and (II):

G, T and Q are each independently functional groups selected from the group consisting of COOH, OH, SH, NH₂, NHR¹, (NHC(=NH))_mNH₂, R²COOH, R²OH, NR¹₂, C(O)NHR¹, R²NR¹₂, R²SH, R²NH₂ and R²NHR¹, wherein R¹ is a hydrocarbon group, R² is an alkylene or alkylidene group and m is a number in the range of 1 to

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about 4; T can also be R^1 , OR^1 or $SO_2C_6H_4NH_2$; and Q can also be H.